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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,013	07/10/2001	Wei-Sing Chu	2313-117	8860

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EXAMINER

CHIN, CHRISTOPHER L

ART UNIT PAPER NUMBER

1641

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/901,013

**Applicant(s)**

CHU, WEI-SING

**Examiner**

Christopher L. Chin

**Art Unit**

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 80-83 and 92-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 80-83 and 92-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 80-83 and 92-96 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 80 and 92 are vague and confusing because it is not clear as to how the sample or tissue is related to the robotic system (claim 80) or system of robotics (claim 92) for the reasons of record in the previous office action.

In response to this rejection, Applicants have amended the preambles of claims 80 and 92 to indicate that the systems are for moving the sample or tissue and argue that it would be clear to those skilled in the art that the tissue or sample is related to the robotic system in that the robot system is for moving a sample or tissue between reaction chambers.

Applicant's amendments and arguments have been considered but are not convincing to overcome this rejection. The amendment to the preambles of claims 80 and 92 now recite an intended use for the claimed robotic system (claim 80) and system of robotics (claim 92). However, the intended use does not clarify how the sample or tissue is structurally related to the systems. Apparently, the sample or tissue is intended to be components of the claimed system. As such their structural relationship to the system has to be clearly set forth. Applicant's argument that an intended use would be sufficient for one skilled in the art to discern the relationship of the sample or tissue to the system is also not convincing because an intended use only states what the

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component in question is to do and not how the component in question is structurally related to the system.

2. Claims 92-96 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification, as originally filed, does not provide support for a "system of robotics" as recited in new claims 92-96. There is no literal support for such a system in the originally filed specification. This phrase suggests a system with a plurality of robots, i.e. "robotics", which is not supported by the originally filed specification.

In response to this rejection Applicants argue that the recitation of "system of robotics" is equivalent grammatically to the phrase "robotic system". Applicants further argue that there is no requirement that every element of a claim be supported literally by the specification.

Applicant's arguments have been considered but are not convincing. Contrary to Applicant's argument, the phrases "system or robotics" and "robotic system" are not grammatically equivalent. A "system of robotics" suggests a plurality of robots whereas a "robotic system" could be a single robot. The phrase "robotic system" would not provide direct or even indirect support for a "system of robotics".

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3. Claims 80-83 and 92-96 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification, as originally filed, does not provide adequate written description for the robotic system or system of robotics recited in claims 80-83 and 92-96 for the reasons of record in the previous office action.

In response to this rejection Applicants argue that the office action has shown no essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art.

Applicant's arguments have been considered but are not convincing. Based on Applicant's arguments, it would appear that Applicants are of the opinion that robots are so well known in the art that the specification need not provide any detailed description of the robot or its components to satisfy the written description requirement under 112 1<sup>st</sup> paragraph. As pointed out in page 5 of the previous office action, the written description requirement under 112 1<sup>st</sup> paragraph serves at least two purposes, 1) show that applicant has invented the subject matter which is claimed; and 2) show that applicants had possession of the claimed invention. While the specification need not show every robot known in the art, there has to be adequate written description showing the claimed robot. The claimed robot is recited as being capable of moving a sample or tissue and an ultrasound transducer from one reaction chamber to another. The instant

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specification fails to adequately describe such a robot that can perform the claimed function. Without such a disclosure, one cannot discern whether applicants invented the claimed subject matter or even had possession of the claimed invention. The robot is the essential and critical element of the claimed invention. How can there be adequate written description when the essential/critical element of the claimed invention is not described in the instant specification in any detail?

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher L. Chin whose telephone number is (571) 272-0815. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher L. Chin  
Primary Examiner  
Art Unit 1641

5/16/05